

REMARKS/ARGUMENTS

The foregoing amendments in the specification and claims fully supported by the specification and claims as originally filed, and do not add new matter.

Prior to the present amendment, Claims 58-63 were pending in this application. With this amendment, Claims 63 has been canceled without prejudice and Claim 58 has been amended to further clarify what applicants have always regarded as their invention. Support for the recitation of an "isolated" antibody is found in the specification at, for example, page 132, lines 29-38.

Claims 58-62 are pending after entry of the instant amendment. Applicants expressly reserve the right to pursue any canceled matter in subsequent continuation, divisional or continuation-in-part applications.

I. Priority

Applicants thank the Examiner for granting the priority date of the instant application as March 8, 1999.

II. Specification

As requested by the PTO, Applicants have reviewed the application and deleted all references to embedded hyperlinks and/or browser-executable code. Further, the ATCC address on page 372, line 34, has been amended and the paragraph beginning at page 374, line 32, has been amended to comply with the provisions of the Budapest Treaty.

III. Information Disclosure Statement

In response to the Examiner's assertion that the BLAST results cited in the Information Disclosure Statement submitted on March 19, 2002 are not true publications with a publication date, Applicants file herewith, an Information Disclosure Statement listing each reference of the "BLAST Search" separately and including authors/inventors, relevant accession numbers and publication dates. Applicants respectfully request that the listed information be considered by the Examiner and be made of record in the above-identified application.

IV. Claim Rejections Under 35 U.S.C. §101

Claims 58 and 63 are rejected under 35 U.S.C. §101 because allegedly "the claimed invention is directed to non-statutory subject matter." The Examiner states that the claims should be amended to indicate the hand of the inventor by the insertion of the term "isolated" or "purified." (Page 3 of the instant Office Action).

Without acquiescing to the propriety of this rejection and solely in the interest of expedited prosecution in this case, Applicants have canceled Claim 63 and have amended Claim 58 (and, as a consequence, those claims dependent from the same) to recite an isolated antibody. Support for the recitation of an "isolated" antibody is found in the specification at, for example, page 132, lines 29-38.

Accordingly, withdrawal of the rejection of Claim 58 under 35 U.S.C. §101 is respectfully requested.

V. Claim Rejections Under 35 U.S.C. §112, Second Paragraph

Claims 58 and 63 are rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. The Examiner asserts that "[n]either the art nor the specification provide a clear definition for, or distinction between, 'binds' and 'specifically binds'. Therefore, the metes and bounds of the claimed invention cannot be determined."

Without acquiescing to the propriety of this rejection and solely in the interest of expedited prosecution in this case, Applicants have canceled Claim 63 and have amended Claim 58 (and, as a consequence, those claims dependent from the same) to recite "specifically binds." Applicants submit that the art-recognized meaning of "specific" binding is that the antibody that specifically binds to a particular antigen does not significantly cross-react with another antigen. Therefore, the term "specifically binds" in Claim 58 (and, as a consequence, those claims dependent from the same) clearly refers to an antibody that is able to bind to the PRO337 polypeptide without significantly cross reacting with another antigen.

Applicants further submit that the terms "specific binding" and "specifically binds" are well known terms of art in antibody technology. One skilled in the art understands that specific binding means that an antibody binds to a unique epitope within a target sequence. Example 16 of the U.S. Patent Office's Synopsis of Application of Written Description Guidelines clearly acknowledges that considering the routine and art-recognized methods of making antibodies, the

well defined characteristics of the five classes of antibodies, the functional characteristics of antibody binding, and the fact that the antibody technology is well developed and mature, the disclosure of an antigen implicitly discloses an antibody which binds to that antigen. This general determination is equally true to antibodies which "specifically bind" to a target antigen, since such antibodies can be identified by routine screening in routine competitive binding assays.

The specification provides methods to determine whether an antibody specifically binds to epitopes possessed by SEQ ID NO:337. Routine methods of determining antibody binding specificities, including immunoprecipitation, or competitive binding assays such as radioimmunoassay (RIA) or enzyme-linked immunoabsorbent assay (ELISA), are disclosed in the specification at, for example, page 218, lines 17-20. Methods of determining the binding affinities of antibodies using Scatchard analysis are disclosed at page 218, lines 20-21. In addition, a method of using competitive binding assays to determine if a peptide shares an antigenic determinant for a particular antibody with a PRO polypeptide is disclosed in the specification at page 325, lines 25-28.

Accordingly, one skilled in the art would exactly know what the scope of the invention is, and withdrawal of the rejection of Claim 58 under 35 U.S.C. §112, second paragraph, is respectfully requested.

VI. Claim Rejections Under 35 USC §102

Claims 58-61 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Struyk *et al.* (The Journal of Neuroscience, 15(3):2141-2156, March 1995). Struyk *et al.* teach an isolated polypeptide having 91% amino acid sequence identity with SEQ ID NO:523, and a polyclonal antibody that binds to this polypeptide.

Applicants respectfully point out that Claim 58, and, consequently, those claims dependent from the Claim 58, recites "an isolated antibody that specifically binds to the polypeptide of SEQ ID NO:523." Applicants respectfully submit that the term "specific binding" recited in Claim 58 refers to an antibody that binds to a particular epitope without binding to another epitope. Therefore, Claim 58 and the claims dependent from Claim 58, carrying its recitations, clearly refer to an antibody that is able to bind to a specific epitope of the PRO337 polypeptide of SEQ ID NO:523 *without* cross reacting with other epitopes, including those found

in the sequence disclosed in Struyk *et al.* One of ordinary skill in the art would readily understand that given the substantial divergence in sequence between the amino terminal regions of SEQ ID NO:523 and the polypeptide of Struyk *et al.* (as shown in Exhibit A of the instant Office Action), antibodies raised, for example, to the amino terminal region of SEQ ID NO:523 would specifically bind to SEQ ID NO:523, and would not bind to the polypeptide of Struyk *et al.* In view of this, the Examiner errs in assuming that the antibodies claimed in the present application would display significant binding to the polypeptide of Struyk *et al.*, and thus overlap with the antibodies disclosed in Struyk *et al.* As a result of the requirement of specific binding, the claims pending in this application do not encompass antibodies that specifically bind to epitopes found in the polypeptide of Struyk *et al.*

Applicants respectfully submit that a rejection under 35 U.S.C. § 102 can only be proper if the cited reference recites every element of the rejected claim. "For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be shown in a single reference." See *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). M.P.E.P. §2131 further provides, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). 'The identical invention must be shown in as complete detail as contained in the ... claim.' *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)." The antibodies of Struyk *et al.* do not bind specifically to SEQ ID NO:523, as recited in the claims, and therefore the antibodies of Struyk *et al.* do not anticipate the claimed antibodies.

Accordingly, withdrawal of the rejection of Claim 58 under 35 U.S.C. §102(b) as anticipated by Struyk *et al.* is respectfully requested.

VII. Claim Rejections Under 35 USC §103

Claims 58-63 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Struyk *et al.* in view of De Boer (U.S. Patent No. 5,874,082, filed February 23, 1996). Struyk *et al.* teach an isolated polypeptide having 91% amino acid sequence identity with SEQ ID NO:523, and a polyclonal antibody to this polypeptide. De Boer teaches monoclonal antibodies, humanized antibodies, antibody fragments, and labeled antibodies.

As discussed above, Struyk *et al.* does not disclose each and every limitation of Claims 58, or those claims dependent upon Claim 58, because Struyk *et al.* does not disclose antibodies that specifically bind to SEQ ID NO:523. De Boer does not cure the deficiencies of Struyk *et al.*, as De Boer teaches only general forms of antibodies, but does not disclose antibodies that specifically bind to SEQ ID NO:523. Thus Applicants respectfully submit that the instant claims are not obvious over Struyk *et al.* in view of De Boer.

Accordingly, withdrawal of the rejection of Claims 58-62 under 35 U.S.C. §103(a) over Struyk *et al.* in view of De Boer is respectfully requested.

CONCLUSION

In conclusion, the present application is believed to be in *prima facie* condition for allowance, and an early action to that effect is respectfully solicited. Should there be any further issues outstanding, the Examiner is invited to contact the undersigned attorney at the telephone number shown below.

Please charge any additional fees, including fees for additional extension of time, or credit overpayment to Deposit Account No. 08-1641 (referencing Attorney's Docket No. 39780-2630 P1C13).

Respectfully submitted,

Date: September 9, 2005

By: Barrie D. Greene
Barrie D. Greene (Reg. No. 46,740)

HELLER EHRMAN LLP
275 Middlefield Road
Menlo Park, California 94025
Telephone: (650) 324-7000
Facsimile: (650) 324-0638

SV 2144814 v1
9/9/05 11:21 AM (39780.2630)